UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,837	01/16/2002	Maria Azua Himmel	AUS920010511US1	5727

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)	
Office Action Summary	10/047,837	HIMMEL ET AL.	
	Examiner	Art Unit	
	Wen-Tai Lin	2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 December 2008</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-10,13-16,18-27,31-37 and 39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-10, 13-16, 18-27, 31-37 and 39</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail. Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20090211

DETAILED ACTION

1.   Claims 1-10, 13-16, 18-27, 31-37 and 39 are presented for examination.

2.   The text of those sections of Title 35, USC code not included in this action can be found
in the prior Office Action.

Claim Rejections - 35 USC § 103

3.   Claims 1-2, 5-10, 13-16, 18-27, 31-37 and 39 are rejected under 35 U.S.C. 103(a) as
being unpatentable over Rossmann et al.(hereafter "Rossmann")[U.S. 20040111669].

4.   As to claim 1, Rossmann teaches the invention substantially as claimed including: a
method comprising:

        recording, on a captor computer [e.g., 301, Fig. 3], a destination address of a
communications terminal having an electronic telephone directory [e.g., paragraphs 60-63; note
that based on the fact that Rossmann's captured data can be sent from the captor computer to a
remote user terminal for related operations (see claims 13-17), the destination address of the user
terminal must be known to the captor computer];

        capturing one or more telephone number records from a Web page displayed on the web
browser using the captor computer [paragraphs 44-45, 60-63, 68 and 78; e.g., saving a captured

telephone in a PIM or a telephone book, wherein the act of selecting one or more telephone

numbers may be accomplished by invoking the related operations]; and

    sending a message containing the one or more captured telephone number records from

the captor computer to the destination address of the communications terminal [e.g., Abstract and

claim 17; that is, in Rossmann's system either the browser of the communication terminal or the

servers 308 or 316 of Fig.3 can be used for saving the phone numbers into a local PIM].

    For the scenarios when the communication terminal is <u>not</u> the captor computer:

Rossmann does not specifically teach that the destination address of the communications

terminal is recorded in a web browser.

    However, recording favorite destination address in terms of URLs in as browser's

bookmarks is well known in the art.

    It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have recorded the destination address of the communications terminal as a

bookmark because: (1) Rossmann's captor computer needs to supply various destination

addresses of designated terminal communication terminals for subsequent "related operations";

and (2) the browser's bookmark storage is known to keep a variety of URLs that are accessible

to the users (e.g., via a browser) and processes (e.g., via a file system) [e.g., paragraphs 2, 69-70

and 76-78].

5.   As to claim 2, Rossmann further teaches:

receiving, in the communications terminal, the message containing the one or more

captured telephone number records from the captor computer; and recording the one or more

telephone number records into the electronic telephone directory of the communications terminal

[e.g., paragraphs 60-63 and claim 17; note that the extracted phone numbers and the "related

operations" together form a message, which is sent to the communication terminal for saving the

phone numbers into a local PIM].

6.   As to claims 5-6, Rossmann further teaches that the communications terminal is selected

from a mobile telephone, a personal computer, a voice mail messaging service, a FAX machine,

a handheld computer, a personal digital assistant or combinations thereof, wherein the

communications terminal is selected from a device that can store and retrieve information and is

connectable to a telephone network, a device that can store and retrieve information and is

connectable to a computer network or combinations thereof [e.g., 301, Fig.3 or 400, Fig.4].

7.   As to claim 7, Rossmann further teaches that the destination address for the

communications terminal is selected from a computer network address, an Internet address, and

telephone number [e.g., paragraphs 69 and 78; i.e., the URL is an Internet address designating

where the extracted phone numbers are to be stored in a local PIM].

8.   As to claims 8-9, Rossmann further teaches that the one or more telephone number

records comprises a telephone number and an alphanumeric identifier for the telephone number,

wherein the telephone number record comprises parameters selected from a telephone number,

contact name, an address, a FAX number, an e-mail address, a hyperlink to a Web site, a

business name, a business specialty, business hours or combinations thereof [paragraphs 64-68;

i.e., when the data type is a "person", then a telephone number is associated with the person's

name and other attributes such as address, which are alphanumeric identifiers for the telephone

number when uses the person's name or address as a key to extract the phone number from the

PIM records or database.

9.   As to claim 10, Rossmann further teaches that the step of recording the destination

address comprises:

        selecting a menu function on the browser for recording the communications terminal's

destination address; specifying the destination address on an interactive display provided by the

browser; and saving the destination address within the browser program.

        [Note that the above steps are inherent procedures for recording a communications

terminal's destination address in a bookmark accessible by the browser].

10.   As to claims 13-14, Rossmann further teaches that each telephone number record

comprises a telephone number and an alphanumeric identifier for the telephone number [e.g., the

telephone owner's name], the method further comprising:

        editing the alphanumeric portion of the chosen telephone number record, wherein the

editing better identifies the telephone number [e.g., it is easier to locate a telephone by

associating the telephone number with its owner's name]; and

editing the telephone number portion of the chosen telephone number record, wherein the editing makes the telephone number compatible with the communication terminal's telephone system, and wherein the telephone number record is displayed in a standard format suitable for a format of the electronic telephone directory.

[Note that the above steps are nominal procedure of editing a PIM record wherein the alphanumeric identifier is the person's name, and the phone number and address are the attributes of the name. See also paragraphs 64-68 for more details as how a telephone number may be part of the attributes of a person in a PIM].

11.   As to claim 15, Rossmann teaches automatically capturing telephone numbers from a web page to a telephone directory such as PIM (personal Information Manager). Rossmann does not specifically teach the option of displaying a telephone number record dialogue box; and receiving an instruction from a user identifying the one or more the telephone number records to capture.

However, the above telephone entering method is obvious in operating a PIM in its nominal mode [e.g., paragraph 9]. That is, by manually entering the telephone numbers to be entered in a dialog provided by the PIM and instruct the PIM to save the telephone numbers into its local database. Thus, it would have been obvious to maintain this manual option to the user, because this is a complementary method for entering data into a user's PIM [note that claim 1 allows the captor computer to be the destination of the captured telephone destination – meaning that the user who browses the web page is also the owner of the PIM].

12.   As to claims 18-19, Rossmann does not specifically teach marking the message with a

password which is recorded on the browser with the destination address of the communications

terminal, and determine that the message contains a telephone directory record, discarding the

message if the message is not marked with a password.

       However, it is well known in the art of secured communication for only allowing a

message marked with authentication information (such as a password) to be transferred to a

destination.

       It would have been obvious to one of ordinary skill in the art that, when the

communication terminal is situated in a secured network or the user's PIM is to be securely

guarded, Rossmann's message (which include captured telephone numbers and instructions to

updating the same) needs to be authenticated because by doing so it enhances the integrity of the

local telephone directory by preventing the telephone records from being modified by an

unauthorized person.

13.   As to claim 20, Rossmann teaches that the PIM destination of the captured telephone

numbers can be located at a remote website or a remote communications terminal [e.g., claim

17]. Rossmann does not specifically teach providing notification that the message has arrived at

the destination address.

       However, sending a notification or acknowledgement to the originator of a message that

the intended information has been securely transferred is obvious in the art [e.g., a TCP protocol

employs retransmission mechanism for a lost packet]. It would have been obvious to one of

ordinary skill in the art that Rossmann's system may adopt the similar protocol because it

enables the sender to retransmit a message if it is determined that the message has been lost.

14.   As to claims 16, 21-27, 31-37 and 39, since the features of these claims can also be

found in claims 1 and 5-9, they are rejected for the same reasons set forth in the rejection of

claims 1 and 5-9 above.

        As for the additional limitations requiring the use of a computer program product for

performing the steps of claim 27: see Rossmann's teaching in paragraph 99 and claims 18-29.

        As for the additional limitation requiring "downloading a Web page containing a

telephone number record tailored for the geographical location of the destination address" in

claim 37: it is noted that a telephone having an area code [see the listed telephone number in

paragraph 88] is in a form "tailored for the geographical location of the destination address"

because the associated area code makes it possible to make a call from anywhere in the country.

15.   Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et

al.(hereafter "Rossmann")[U.S. 20040111669], as applied to claims 1-2, 5-10, 13-16, 18-27, 31-

37 and 39 above, further in view of Official Notice .

16.   As to claim 3, Rossmann further teaches that that the selected data type (such as

telephones) contained in a web page can be extracted and stored in a telephone book (PIM) via a

set of user selected operations [e.g., paragraph 81: "For example, for a "phone number" data

type, there might exist operations to perform a reverse lookup on a phone number, add the phone number to a PIM, etc."].

Rossmann does not specifically teach the detailed procedures as to how the selected operations include: searching the existing electronic telephone directory to see if the number to be entered already exist or not, and if it does, then notify the user of the existence.

However, Official Notice is taken that this additional feature is well known in the art. For example, a user is warned when an attempt to overwriting a record of a file is made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to follow this conventional procedure to update Rossmann's telephone directory because the procedure ensures the integrity of the directory.

17.   As to claim 4, Rossmann does not specifically teach how a telephone record in the telephone directory is updated (e.g., deleting, adding, or modifying a record).

However, Official Notice is taken that the listed feature is a typical procedure in the art of updating a PIM record or a database.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to adopt the conventional updating procedure in updating Rossmann's PIM because such procedure ensures the integrity of the PIM.

18.   Applicant's arguments filed on 12/0/08 for claims 1-10, 13-16, 18-27, 31-37 and 39 have been fully considered but they are not deemed to be persuasive.

19.   Applicant argues in the remarks that:

        (1) Applicant's claim 1 requires that the communication terminal and the captor computer
are separate entities, but based on the cited passages it appears that the examiner equated the
communication terminal with the captor computer, or equated the "destination address" with the
"one or more telephone records."

        (2) Applicant asserts that bookmarking a favorite web page in a browser is not the same
as "recording … a destination address of a communication terminal having an electronic
telephone directory."

        (3) In the rejection of claim 20, the examiner cited claim 17 of Rossman. However, claim
17 of Rossman, along or in combination with any of the related claim does not teach a PIM, "a
remote website", or "a remote communication terminal."

20.   Examiner respectfully disagrees with applicant's remarks:

        As to point (1): Applicant is reminded that claim 1 was rejected under USC 103(a)
instead of USC 102. In the rejection the examiner admitted that Rossmann is silent about the
feature of recording a destination address (of a communication terminal) in a browser. The
examiner further cited claim 17 of Rossmann to indicate that the captor computer and the
communication terminal are two separate entities [see claims 13-17, wherein the processor
(which receives a web page containing telephone numbers) and the user terminal are coupled
through a network]. Applicant appears to be confused by the cited numerals and passages: "301,
Fig. 3; paragraphs 60-63", wherein "301, Fig. 3" is meant to refer to the captor computer and
paragraphs 60-63 clearly points to a communication terminal having a PIM. Thus, in order for

the captor computer to send message/data to the communication terminal, the former must be in

possession of the destination address of the latter.

As to point (2): Applicant is reminded that the specification at paragraphs 9 and 32

indicates that the destination address for the intended communication terminal is recorded in the

"preferences on the browser", which is referenced to 15b of Fig. 1 and is separate from the

browser 15a of Fig. 1. Since the browser is only an executable code, the so called "recording …

in a browser" can only be broadly interpreted as "stored in a memory area that is accessible to

the browser". For example, information such as bookmarked URLs and cached web pages are

viewed as being stored "in the browser". If this interpretation is incorrect, Applicant is requested

to clarify and show evidence otherwise.

As to point (3): Applicant is directed to claims 13-17 of Rossmann and the cited passages

in the rejection of claims 1-2 and 20 of the instant office action.

For at least the foregoing reasons, it is submitted that the prior art of record reads on the

claims.

21.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

22.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this

final action.

        Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The

examiner can normally be reached on Monday-Friday (8:00-5:00) .

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nathan Flynn can be reached on (571)272-1915. The fax phone numbers for the

organization where this application or proceeding is assigned are as follows:

                (571) 273-8300 for official communications; and

                (571) 273-3969 for status inquires draft communication.

        Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

February 11, 2009

/Wen-Tai Lin/

Primary Examiner, Art Unit 2454